

REMARKS/ARGUMENTS

Reconsideration of the present patent application, as amended, is respectfully requested.

In the specification, typographical errors were found on pages 7 and 9, and have been corrected.

Of pending claims 1-5, all were rejected. The claims were rejected on two principal grounds. First, the claims were rejected as being anticipated under 35 U.S.C. §102(b), or in the alternative, as being obvious under 35 U.S.C. §103(a), over a previously cited paper by Chan, “Architectural Tradeoffs in Field-Programmable-Device-Based Computing Systems,” FPGAs for Custom Computing Machines, Proceedings, IEEE Workshop in Napa, CA USA 5-7 April 1993, pages 152-161. Secondly, the claims were rejected under the judicially created doctrine of obviousness-type double patenting over claims 1-3, 10 and 27 of U.S. Patent No. 6,693,456.

With respect to the first grounds of rejection, the applicant respectfully disagrees. As the applicant argued in the parent application, U.S. App. No. 09/923,294, which resulted in U.S. Patent No. 6,693,456, the Chan paper taught that combinations of programmable integrated circuits including FPGAs may be used to design general purpose FPGA-based computing systems with field programmable gate arrays and field programmable interconnects. There was no discussion or mention of programmable switches arranged in a Beneš network to create an FPGA. Analysis of the computing system network was made with Clos network theory. Furthermore, the applicant does not claim a system, but rather an integrated circuit. However, the Examiner stated, “The recitation that, ‘an integrated circuit’ has not been given patentable weight because it has been held that a preamble is denied the effect of a limitation where the claim is drawn to a structure and the portion of the claim following the preamble is a self-contained description of the structure not depending for completeness upon the introductory clause. *Kropa v. Robie*, 88 U.S.P.Q. 478 (CCPA 1951).”

This is a misapplication of *Kropa v. Robie*. In describing the line between giving a limiting effect to a preamble or not, the court stated, “...it appears that the preamble has been denied the effect of a limitation where the claim or count was drawn to and the portion of the

claim following the preamble was a self-contained description of the structure not depending for completeness upon the introductory clause; or where the claim or count was drawn to a product and the introductory clause merely recited a property inherent in the old composition defined by the remaining part of the claim. In those cases, the claim or count apart from the introductory clause completely defined the subject matter, and the preamble merely stated a purpose or intended use of that subject matter....[W]here the preamble to the claim or count was expressly or by necessary implication given the effect of a limitation, the introductory phrase was deemed essential to point out the invention defined by the claim or the count. In the latter class of cases, the preamble was considered necessary to give life, meaning, and vitality to the claim or counts (underlining added).” 88 U.S.P.Q 480-481.

The preamble in the applicant’s claims does not state merely a purpose or intended use. Rather, the preamble is essential to point out the applicant’s invention. It is not an apple, automobile, microbe, chemical composition, combinations of programmable integrated circuits, but rather “an integrated circuit.”

Indeed, the preamble in the applicant’s claims is necessary to give life, meaning and vitality to the claims in a situation very similar to the holding in the *Kropa* case which arose out of an interference. The count/claims at issue was the preamble of “an abrasive article,” followed by the elements of abrasive grains and hardened binder of enumerated composition. In his earliest applications the appellant had disclosed the elements but not an abrasive article. At the interference and subsequent cases, the appellant contended that the term did not introduce a limitation into the count/claims and should be given no weight so that he could rely upon the filing dates of his earliest applications. The court held that “abrasive article” did introduce a limitation into the count/claims. “In the case before us, the words ‘An abrasive article’ are essential to point the invention defined by the counts. In our judgment those introductory words give life and meaning to the counts, it is only by that phase that it can be known that the subject matter defined by the claims is comprised as an abrasive article. Every union of substances capable inter alia or use as abrasive grains and a binder is not an ‘abrasive article.’” 88 U.S.P.Q 481.

“An integrated circuit” is essential to point out the applicant’s invention; it is only by that phrase that it can be known that the subject matter defined by the claims is comprised as an integrated circuit. The court’s reasoning above can be applied precisely in the same manner to the applicant’s claims. Claims 1-5 should be allowed over the Chan paper.

As part of this rejection, the Examiner rejected the phrase, “the plurality of latches responsive to clock signals,” because “a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 U.S.P.Q.2nd 1647 (1987).” To obviate this rejection, the applicant has amended claims 4 and 5 to remove the offending preposition, “for,” and indications of intentionality.

Secondly, with respect to the rejections based by obviousness-type double patenting, the applicant will submit a Terminal Disclaimer pursuant to 37 CFR §1.321 upon allowance of the claims.

Therefore, in view of the amendments and the remarks above, the applicant respectfully requests that all the rejections be removed, that claims 1-5 be allowed, and that the case be passed to issue. If a telephone conference would in any way expedite the prosecution of the application, the Examiner is asked to call the undersigned at (408) 446-7687.

Respectfully submitted,


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